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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,723	09/29/2003	Harold F. Carrison	03-119 (US01)	3995

41696 7590 09/18/2008  
VISTA IP LAW GROUP LLP  
12930 Saratoga Avenue  
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Saratoga, CA 95070

EXAMINER
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COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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09/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,723	<b>Applicant(s)</b> CARRISON ET AL.	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 and 12-16 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 103,039 (Gerecke) in view of US Pat. No. 111,475 (Roble).

Gerecke discloses a device comprising a pair of rigid members each having a proximal portion A and a distal portion wherein are mounted a plurality of flutes B (see Figure). The device is configured to be placed in a collapsed state wherein the flutes are in an interposed arrangement with respective proximal portions of the first and second members spaced apart from each other. The device comprises a hinge. At least a distal portion of the device would be capable of fitting within a vertebra. Gerecke does not explicitly disclose using a biocompatible material or a plurality of flutes on both members. However, Roble discloses a similar device and teaches that a plurality of flutes can be used on both members "to facilitate the operation and give a more satisfactory finish to the work." (See, e.g., Fig. 1 and col. 1, lines 10-13.) Regarding the material used, it would have been obvious to have formed the device from, for example, titanium (which is biocompatible) in order to make the device light and strong.

Art Unit: 3733

Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Allowable Subject Matter***

Method claims 8-10 and 12-16 are allowable over the prior art of record.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 02 June 2008 have been fully considered but are not persuasive.

It is first noted that the cited art satisfies the claimed structural limitations and the device is at least capable of satisfying the general and broad statement of intended use in the apparatus claims, i.e. "for treating bone" (for example, the device could be used to hold, support, or manipulate bones). Regarding Applicant's arguments pertaining to analogous art, it is noted that the combined references must be analogous to each other (as they are in the instant case) to assert that it would have been obvious to combine them. Moreover, the resulting structure satisfies the claimed limitations. Likewise, it would have been obvious to have substituted a known material such as titanium for its known properties and advantages (e.g., light weight and strength), and titanium is

Art Unit: 3733

inherently biocompatible. Applicant's argument pertaining to the prongs of Gerecke being made of iron or steel wire is taken out of context. Gerecke emphasizes that the material must not "become roughened by the action of heat" and must not be cast. The material is presented in the alternative as an example of a material that satisfies the requirements that it not be cast and that it not become roughened by the action of heat. Titanium is also capable of satisfying these requirements and would be a suitable material. Moreover, Applicant's conclusion that titanium would not have been used since the device of Gerecke was not intended for the human body would be persuasive if the only application of titanium were in the human body. However, of course, titanium is used for its various properties and advantages in myriad applications beyond the human body. In addition, considerations of material cost are not only relative but also variable and therefore inconclusive. In short, there are plenty of reasons for a person of ordinary skill in the art to select a known material such as titanium, which satisfies the stated material requirements. In response to Applicant's argument that Gerecke and Roble cannot be combined, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Here, the combination would be obvious for the reasons set forth in the rejection, and the resulting structure satisfies the claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/674,723

Page 6

Art Unit: 3733

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733